

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:	Mark A. FELKEY <i>et al.</i>	Confirmation No.:	7571
Application No.:	10/051,282	Examiner:	Thien, Maria Teresa T.
Filed:	January 22, 2002	Group Art Unit:	3627
Attorney Docket No.:	WMA01001		

For: **METHOD AND SYSTEM FOR PROCURING TELECOMMUNICATIONS
 SERVICES ON-LINE**

Commissioner for Patents
Alexandria, VA 22313-1450

REPLY BRIEF

Dear Sir:

This Reply Brief is submitted in response to the Examiner's Answer mailed July 25, 2011.

I. STATUS OF THE CLAIMS

Claims 1, 3, 7-10, 12, 14, 21, 22, 27 through 30, 32 through 35, and 37 through 41 are pending. Claims 37 through 39 stand withdrawn from consideration pursuant to the provisions of 37 C.F.R. §1.142(b). Claims 2, 4 through 6, 11,13, 15 through 20, 23 through 26, 31, and 36 have been canceled. Claim 28 is an original claim. Claims 1, 3, 7 through 10, 12, 14, 21, 22, 27, 29, 30, 32 through 35, 40, and 41 were previously presented. No claim is allowed. This appeal is therefore taken from the final rejection of claims 1, 3, 7-10, 12, 14, 21, 22, 27-30, 32-35, 40, and 41 on September 2, 2010.

II. GROUND OF REJECTION TO BE REVIEWED

Claims 1, 3, 7 through 10, 12, 14, 21, 22, and 35 were rejected for obviousness under 35 U.S.C. §103(a) based on *Leonard* (US 6,085,171) in view of *Bednarek* (US 6,965,868).

Claims 27 through 30 and 32 through 34 were rejected for obviousness under 35 U.S.C. §103(a) based on *Leonard* (US 6,085,171) in view of *Bednarek* (US 6,965,868) and further in view of *Sridhar et al.* (US 6,098,108).

Claims 40 and 41 were rejected for obviousness under 35 U.S.C. §103(a) based on *Leonard* (US 6,085,171) in view of *Bansal* (US 6,788,949).

III. ARGUMENT

Initially, Appellants maintain and incorporate herein the arguments advanced in the Appeal Brief filed April 21, 2011. The arguments presented *infra* address certain new assertions presented by the Examiner in the Answer.

A. Rejection of claims 1, 3, 7 through 10, 12, 14, 21, 22, and 35 under 35 U.S.C. §103(a).

At pages 13 to 14 of the Answer, in response to Appellants' argument that *Leonard* does not disclose "pre-sale" procurement inquiries, the Examiner asserted that since a user is looking to change to a new service provider, as to that new service provider, the user is a "prospective subscriber" and, therefore, an inquiry by the user is a "pre-sale" procurement inquiry. Appellants respectfully disagree.

The Examiner's rationale only looks at the user as a prospective subscriber of a new service provider. However, since the user in *Leonard* is admittedly already a subscriber to another service provider, that user is also a "current subscriber." If the user is a current

subscriber to another service provider, this means that there was a previous sale at some time when the subscriber subscribed to his/her current service provider. Since there was a previous sale, it is not fair to interpret the user in Leonard as “**a customer who is not yet a subscriber [but] is considering a subscription**” and it is not fair to characterize the customer’s inquiry in Leonard as a “**pre-sale procurement inquiry**.”

At pages 15 to 18 of the Answer, responsive to Appellants’ argument that neither Bednarek nor Leonard provides for an option to access a network consultant via instant messaging, the Examiner asserted that Bednarek teaches such an option. Appellants respectfully disagree. As previously argued in the Appeal Brief, Bednarek discloses communication with a sales agent and even that that communication may be by instant messaging. However, and this is key, in Bednarek, the customer does not have the **option** to access a network consultant via instant messaging. Rather, in Bednarek, the customer must **always** eventually contact a consultant. **Such contact is not optional on the customer’s part.**

At page 17 of the Answer, the Examiner acknowledged that, in Bednarek, “[a] customer can enter the vtail website and select either their sales agent or the first available agent.” Either way, whether the customer deals with a specified sales agent or the first available agent, the customer must still deal with an agent in every circumstance. The customer thus has **no option** to contact an agent if he/she wishes. In other words, the customer is not given an alternative by which the customer need not contact an agent if he/she wishes to not interact with the agent. It is this **option, or choice**, by the customer to contact an agent via instant messaging in the claimed invention that is substantially different from anything taught or suggested by Leonard, Bednarek, or any combination thereof.

At page 18 of the Answer, the Examiner asserted that the “marketplace reflects the reality that applying modern electronic communication to older electronic commerce system is commonplace.” It appears that the Examiner has taken the position that because certain communication, i.e., instant messaging, was known, it would have been obvious to apply that type of communication in older commercial systems. Appellants assert that this rationale is too vague as to apply to the claimed invention in any reasonable manner. Without knowing specifically how the Examiner intends to modify Leonard with the teachings of Bednarek, it is difficult to respond to the Examiner’s assertion relative to applying an instant messaging communication in Leonard’s system.

In any event, this is not the issue here. It is not a matter of the obviousness of applying an instant messaging communication to the Leonard system. Rather, the issue here is why would the person of ordinary skill in the art have modified Leonard as to provide for “an option for accessing a network consultant via instant messaging.” Appellants do not deny that instant messaging, *per se*, was known. Appellants do, however, deny that there is any evidence of record suggesting “an **option for accessing a network consultant** via instant messaging” and/or of modifying Leonard in any way, shape, or form to provide for such a specified option.

A review of the prosecution file in this case will show that the only suggestion for providing such an option for accessing a network consultant via instant messaging comes from Appellants’ own disclosure. The use of Appellants’ own disclosure to conclude obviousness is not permitted under 35 U.S.C. §103(a).

Accordingly, the rejection of claims 1, 3, 7 through 10, 12, 14, 21, 22, and 35 under 35 U.S.C. §103(a) is neither factually nor legally viable. Therefore, reversal of this rejection by the Honorable Board is respectfully solicited.

B. Rejection of claims 27 through 30 and 32 through 34 under 35 U.S.C. §103(a).

At pages 20 through 24 of the Answer, responsive to Appellants' argument that the details of independent claim 27, for example, are not described or suggested by any one of Leonard, Bednarek, and/or Sridhar, the Examiner asserted that Sridhar teaches "a back office browser loaded on a back office client computer" and "a server program loaded on a server computer," citing various portions of Sridhar at pages 22 through 23 of the Answer. Appellants respectfully disagree.

The customer browser, back office browser, and server program, recited in independent claim 27, for example, are very specific as to the interrelationship between these elements. For example, the "back office browser loaded on a back office client computer, the back office browser **being configured to submit a service inquiry specifying a search criteria with respect to an order** for a telecommunications offering" (Emphasis Added), and the "**server program** loaded on a server computer and being configured to receive the procurement and service inquiries, **generate procurement data** pertaining to the selected telecommunications offering and service data pertaining to the search criteria, and **transmit the procurement and service data**" (Emphasis Added) are recited in claim 27. Contrary to the Examiner's assertion, these elements and their claimed interrelationship are not disclosed or suggested by Sridhar (or Leonard and/or Bednarek, for that matter).

At pages 22 to 23 of the Answer, the Examiner describes various asserted functions ascribed to Sridhar including communication between a client application and a server application over a data network, communication on a first segment between a client computer and a gateway computer using a transmission control protocol, and communication between a client application and a proxy application using a proxy protocol. The Examiner also describes a

second segment, wherein a proxy application communicates with a server application using an application layer protocol. The Examiner then asserted that all of these asserted communications correspond to the claimed “back office browser loaded on a back office client computer, the back office browser **being configured to submit a service inquiry specifying a search criteria with respect to an order** for a telecommunications offering” (Emphasis Added), and the “**server program** loaded on a server computer and being configured to receive the procurement and service inquiries, **generate procurement data** pertaining the to the selected telecommunications offering and service data pertaining to the search criteria, and **transmit the procurement and service data.**”

However, it is not readily apparent, and the Examiner has not sufficiently explained, how the asserted communications of Sridhar may be interpreted to correspond to the specific elements recited in claim 27. For example, the Examiner asserted, without basis, that “two specific application protocols that are used to communicate between client application and server applications are HTTP for accessing Web pages and data embedded in Web pages and FTP for accessing remotely stored files are considered “a back office browser loaded on a back office client computer” and “a server program loaded on a server computer” (Answer-pages 23 to 24). There is simply no basis for the Examiner’s assignation of the title, “a back office browser loaded on a back office client computer” and “a server program loaded on a server computer” to the application protocols of Sridhar.

Moreover, even if the Examiner’s assignment of these labels were accurate, and Appellants contend that it is not, since the application protocols of Sridhar do not correspond to the claimed “a back office browser loaded on a back office client computer” and “a server program loaded on a server computer,” the Examiner’s simplistic hindsight reconstruction of the

claimed invention simply does not provide for the claimed interrelationships between the elements of claim 27, wherein:

- “a customer browser loaded on a customer client computer, the customer browser being configured to submit a procurement inquiry specifying a selected telecommunications offering from among a voice service offering, a data access service offering and a mobile telecommunications offering, the procurement inquiry being directed at least to one or more telecommunication services to which a customer who is not yet a subscriber is considering a subscription;
- a back office browser loaded on a back office client computer, the back office browser being configured to submit a service inquiry specifying a search criteria with respect to an order for a telecommunications offering, the service inquiry being directed at least to the status of the order of the telecommunication service which a customer who is not yet a subscriber has initiated, wherein a customer agent assigned for servicing a telecommunications offering order is available via instant messaging with the customer client computer; and
- a server program loaded on a server computer and being configured to receive the procurement and service inquiries, generate procurement data pertaining to the selected telecommunications offering and service data pertaining to the search criteria, and transmit the procurement and service data.”

Further, at page 24 of the Answer, the Examiner noted that it would have been obvious to combine Sridhar with Leonard/Bednarek in order to “update the older electronic commerce system...with modern electronic network that are commonly available...” Appellants respectfully disagree.

No combination of Leonard, Bednarek, and Sridhar will result in the claimed invention. Further, the Examiner’s simplistic rationale of “updating” an older electronic system is not based on reality. A mere desire to update an older system would not, in itself, suggest to the skilled artisan how/why to adapt the application protocols of Sridhar to modify Leonard/Bednarek to provide for the very detailed agglomeration of elements and interrelationships specified in claim 27. Generalities do not suffice in establishing a case of *prima facie* obviousness. The Examiner’s rationale for concluding obviousness is a mere generalization (i.e., mere updating of

an older electronic component), falling far short of the “articulated reasoning with some rational underpinnings” required by the U.S. Supreme Court, *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (2007).

Accordingly, the rejection of claims 27 through 30 and 32 through 34 under 35 U.S.C. §103(a) is neither factually nor legally viable. Therefore, reversal of this rejection by the Honorable Board is respectfully solicited.

C. Rejection of claims 40 and 41 under 35 U.S.C. §103(a).

Appellants rely on the previous arguments *supra* and in the Appeal Brief regarding the deficiencies of Leonard. Since Bansal does not cure these deficiencies, no *prima facie* case of obviousness has been established regarding the subject matter of claims 40 and 41.

Accordingly, the rejection of claims 40 and 41 under 35 U.S.C. §103(a) is neither factually nor legally viable. Therefore, reversal of this rejection by the Honorable Board is respectfully solicited.

IV. CONCLUSION AND PRAYER FOR RELIEF

Appellants, therefore, request the Honorable Board to reverse each of the Examiner's rejections.

Respectfully Submitted,

DITTHAVONG MORI & STEINER, P.C.

September 22, 2011

Date

/Phouphanomketh Ditthavong/

Phouphanomketh Ditthavong
Attorney/Agent for Appellant(s)
Reg. No. 44658

Errol A. Krass
Attorney/Agent for Appellant(s)
Reg. No. 60090

918 Prince Street
Alexandria, VA 22314
Tel. (703) 519-9952
Fax (703) 519-9958